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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

08/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/736,374	ARAI ET AL.	
	Examiner	Art Unit	
	KELLY CAMPEN	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The following is in response to the Amendments and arguments filed 04/21/2009. Claims 1-17 are pending, claims 16-17 have been withdrawn from consideration.

Claim Rejections - 35 USC § 101

Applicants' arguments and reasoning have overcome the 35 USC 101 rejections; therefore, the rejection is withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the concept of “scenario digest of multimedia content” is not included in the originally filed disclosure and as such, it is unclear.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3-7, 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "advertisement tenant" in claims 1-15 is used by the claim to mean "a billboard shown in the outline of contents, articles such as a car and a magazine used in the contents, or a character used in the contents." while the accepted meaning is:

"Advertisement" is defined as a notice to attract public attention or patronage while "tenant" is defined as an occupant, inhabitant, or dweller in a place. The term "advertisement tenant" is indefinite because the specification does not clearly redefine the term.

In view of the extensive indefinite concerns in the claims, the following prior art rejection has been made as best as the claims may be interpreted.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Giacalone, Jr. (US 2001/005200).

Specifically as to claim 1, Giacalone, Jr. discloses a digital contents advertisement display computer system using an auction, comprising: a contents distribution unit; a computer processor; and a computer readable medium storing at least one computer program controlling the computer processor to perform operations comprising: distributing by the contents distribution unit through a digital medium a digest of digital contents displayed to one or more audiences; allowing the audiences, as sponsors, to bid for becoming an advertisement tenant in one or more of the digital contents displayed as a scenario digest of multimedia content, when displaying the multimedia content; determining a winning sponsor for the advertisement tenant 'from among the bidding sponsors, according to a highest price bid by a sponsor; and updating the digital contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital contents and distributing the multimedia content including the completed digital contents as the scenario digest with the advertisement tenant via the contents distribution unit (see paragraphs [0009],[0019], [0041],[0048],[0053],figure 6).

Specifically as to claim 2, wherein the computer processor operations further comprise receiving an input from an audience and allowing the audience to influence the scenario digest of the multimedia content (see paragraphs [0009],[0019],[0053],figure 6).

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Specifically as to claims 3 and 4, wherein, in a case where an advertisement tenant is not determined in the determining of the winning sponsor the multimedia content including the digital contents is distributed using a default advertisement tenant in the digital contents (see paragraphs [0009],[0019], and [0041]).

Specifically as to claims 5-6, 11-12, wherein the computer processor operations further comprise controlling behavior of a character displayed in the scenario digest in accordance with a bidding price by a sponsor, wherein the character behaves so that the audience pays more attention to the advertisement tenant for which the bidding price is higher (see paragraphs [0009], [0019]).

Specifically as to claims 7 and 8, wherein the computer processor operations further comprise recording an access log with respect to the character, and calculating a degree of attention to the advertisement tenant based on the access log recording, wherein advertising effects can be measured based on the calculated degree of attention to the advertisement tenant (see paragraphs 0048], [0053], figure 6).

Specifically as to claims 9 and 10, wherein the computer processor operations further comprise changing a display of the advertisement tenant so that a degree of attention to the advertisement tenant in the scenario digest is changed in accordance with a bidding price (see paragraphs [0009], [0019], [0041], [0048], [0053], figure 6).

Specifically as to claims 13 and 14, wherein if the digest of the digital contents are redistributed, the advertisement tenant is auctioned again to the advertisement sponsors (inherent in advertising auctions, see in addition, paragraphs [0019]-[0053]).

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Specifically as to claim 15, Miyashita discloses a computer-readable recording medium storing a program to be executed by a computer, for realizing a digital contents advertisement display system using an auction, the program controlling the computer to perform operations comprising: distributing through a digital medium a digest of digital contents displayed to one or more audiences; allowing the audiences, as sponsors, to bid for becoming an advertisement tenant in one or more of the digital contents displayed as a scenario digest of multimedia content, when displaying the multimedia content; determining a winning sponsor for the advertisement tenant from among bidding sponsors, according to a highest bid price by a sponsor; updating the digital contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital contents; and distributing the multimedia content including the completed digital contents as the scenario digest with the advertisement tenant (see above rejections for claims 1-14, in addition, see paragraphs [0009],[0019], [0041],[0048],[0053],figure 6).

Response to Arguments

Applicant's arguments filed 4/21/2009 have been fully considered but they are not persuasive.

With regards to applicants' arguments directed to the 35 USC 112 second paragraph rejections, Examiner has provided further reasoning and specifically identified errors as requested by applicants.

With regards to applicants' arguments that Giacalone, Jr. does not disclose "distributing ... a digest of digital contents displayed to one or more audiences; allowing the audiences, as

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sponsors, to bid for becoming an advertisement tenant in one or more of the digital contents displayed as a scenario digest of multimedia content when displaying the multimedia content” Examiner disagrees. Giacalone, Jr. discloses distributing a digest to audiences and allowing the audiences to bid for becoming an advertiser on the digest of content in paragraphs [0019], [0009], [0041], [0048], [0053], and figure 6 (including the detailed description of said figure). Giacalone, Jr. is concerned with multimedia content and using a display controller to run on the computer hooked up to the display unit including a dynamic data manager, a media manager, a watchdog and a network interface and an Ad Player (representative of software that can communicate or otherwise transmit various forms of content such as multimedia, broadcast, etc) in paragraph 0048 and figure 2.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/
Primary Examiner, Art Unit 3691